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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,406	12/03/2003	Jason M. Crippen	29351.00	5569
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AHMED, AFFAF				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/726,406

**Applicant(s)**

CRIPPEN ET AL.

**Examiner**

AFAF AHMED

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. This action is in reply to the amendment filed on 04/22/2008.
2. Claims 1, 7, 10, 11, 15 and 19 have been amended.
3. Claims 8, 9 have been canceled.
4. Applicant clarifies claims 2, 3, 13, 14,17,18,21 and 22, therefore, rejections under 35 USC §112 first and second are withdrawn.
5. Claims 1-7 and 10-22 are currently pending and have been examined.

### *Claim Objections*

6. Claims 1, 7, 10, 11, 15 and 19 are objected to because of the following informalities: the claims 1, 7, 10, 11, 15 and 19 are marked as ***"previously presented"***, yet they have been amended. Appropriate correction is required.

### *Response to Applicant's Arguments*

7. Applicant's amendment and arguments filed on 04/22/2008 have been fully considered and discussed in the next section. Applicant is reminded that claims must be given their broadest reasonable interpretations.
8. The examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
9. Examiner would like to point out the Supreme Court in *KSR International Co. v. Teleflex Inc.* described seven rationales to support rejections under 35 U.S.C. 103:
  - Combining prior art elements according to known methods to yield predictable results;
  - Simple substitution of one known element for another to obtain predictable results;
  - Use of known technique to improve similar devices (methods, or products) in the same way;
  - Applying a known technique to a known device (method or product) ready for improvement to yield predictable results;
  - "Obvious to try"-choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

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- Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
- Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine art reference teaching to arrive at the claimed invention

Prior art is not limited just to the references being applied, but includes the understanding of one of ordinary skill in the art. The prior art reference (or references when combined) need not teach or suggest all the claim limitations; however, Office personnel must explain why the difference(s) between prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The "mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." See *Dann v. Johnson*, 425 U.S.219, 230 (1976).

10. Applicant's arguments with respect to claims 1, 7, 10, 11, 15 and 19 have been considered but they are not persuasive. Applicant argues that Bayne does not teach *"determining whether the playback of the advertisement was terminated."* In at least column 5, lines 31-38 discloses advertisers are billed for each advertisement played and in column 7, lines 5-9 discloses advertisers inducing inmate to listen to an advertisement by dialing a toll free number to access an outside line. Furthermore, Bayne in at least column 6, lines 51-67 discloses a call processing center through which the billing module keeps track of the number of times that advertisement messages are played to inmates, where the inmates will be forced to listen to one or more advertisement message as a condition, before they are able to use the service. Therefore, it will be obvious to one of ordinary skill in the art at the time of the invention that the determination of whether a playback of the advertisement was terminated is implicitly implied, since it is a procedure, required by the call center to determine if the inmates listened to the advertisement before they are allowed to make a phone call and properly bill the advertiser.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1, 11, 15, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne, US Pat No: 7,158,621.

**Claims 1, 11, 15 and 19:**

Bayne discloses:

- *selecting an advertisement for playback* (see at least column 3, lines 44-47);
- *playing said advertisement to a caller* (see at least column 9, lines 59-60);

Bayne does not specifically disclose per se:

- *determining whether said caller terminated playback of said advertisement.*
- *billing an advertiser only if said caller did not terminate playback of said advertisement;*

However, Bayne in at least column 5, lines 31-38 discloses advertisers are billed for each advertisement played and in column 7, lines 5-9 discloses advertisers inducing inmate to listen to an advertisement by dialing a toll free number to access an outside line. Furthermore, Bayne in at least column 6, lines 51-67 discloses a call processing center through which the billing module keeps track of the number of times that advertisement messages are played to inmates, where the inmates will be forced to listen to one or more advertisement message as a condition, before they are able to use the service.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the determination of whether a playback of the advertisement was terminated is implicitly implied, since it is a procedure, required by the call center to determine if the inmates listened to the advertisement before they are allowed to make a phone call and properly bill the advertiser.

**Claims 5 and 6:**

Bayne discloses the limitations as shown above.

Bayne further discloses:

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- *a telephone router for routing an unanswered telephone call to said at least one server (see at least column 11, lines 36-48).*
- *a telephone router for routing an unanswered telephone call to said at least one server, said unanswered telephone call being directed originally to a cellular telephone user (see at least column 4, lines 7-8).*

14. Claims 7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne, US Pat No: 7,158,621 in view of Brawn et al, US Pat No: 6665379 and further in view of Pende US Pat No: 6,298,056 B1.

**Claims 7 and 10:**

Bayne discloses:

- *a telephone router for routing an unanswered telephone call to said at least one server (see at least column 11, lines 36-48), said unanswered telephone call being originally directed to a cellular telephone use (see at least column 4, lines 7- 8);*
- *a storage component for advertisements and messages (see at least column 5, lines 13-16);*
- *an input/output component for communicating with said telephone router (see at least column 6, lines 1-17);*
- *selecting an advertisement for playback (see at least column 3, lines 44-47), playing said advertisement to a caller (see at least column 9, lines 59-60);*

Bayne does not specifically disclose per se:

- *determining whether said caller terminated playback of said advertisement,*
- *billing an advertiser only if said caller did not terminate playback including charging said advertiser an advertiser fee;*

However, Bayne in at least column 5, lines 31-38 discloses advertisers are billed for each advertisement played and in column 7, lines 5-9 discloses advertisers inducing inmate to listen to an advertisement by dialing a toll free number to access an outside line. Furthermore, Bayne in at least column 6, lines 51-67 discloses a call processing center through which the billing module keeps track of the number of times that advertisement messages are played to inmates, where the inmates will be forced to listen to one or more advertisement message as a condition, before they are able to use the service.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention that the determination of whether a playback of the advertisement was terminated is implicitly implied, since it is a procedure, required by the call center to

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determine if the inmates listened to the advertisement before they are allowed to make a phone call and properly bill the advertiser.

Bayne does not, but Pende, however does disclose:

- *crediting a user a portion of said advertiser fee* (see at least column 2, lines 61-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pende's crediting subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.

Bayne does not, but Brown, however does disclose:

- *reading a plurality of user customized said advertisement information* (see at least column 11, lines 26-47);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Brown's targeting advertisement to voice messaging system based consumers information with the motivation of providing consumers with preference to customize their voice mail system in order to tailor the function of the system to their desired preferences.

15. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne, US Pat No: 7,158,621 in view of Pende US Pat No: 6,298,056 B1.

**Claim 8:**

Bayne discloses:

- *a means for routing an unanswered telephone call from a caller to a user* see at least column 11, lines 36-48);
- *a means for playing an advertisement for said caller; a means for billing an advertiser for playing said advertisement* (see at least column 9, lines 59-60); *and*
- *a means for receiving a message from said caller* (see at least column 14, lines 30-31).

Bayne does not, but Pende, however does disclose:

- *a means for crediting said user* (see at least column 2, lines 61-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pende's crediting

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subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.

**Claim 9:**

Bayne discloses the limitations as shown above.

Bayne further discloses:

- *wherein said user is a cellular telephone user* (see at least column 4, lines 7-8).

16. Claims 2, 3, 13, 14, 17, 18, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne, US Pat No: 7,158,621 in view of Brawn et al, US Pat No: 6665379.

**Claims 2, 3, 13, 14, 17, 18, 21 and 22:**

Bayne discloses the limitations as shown above.

Bayne does not, but Brown however does disclose:

- *reading a plurality of user customized said advertisement information* (see at least column 11, lines 26-47);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Brawn's targeting advertisement to voice messaging system based consumers information with the motivation of providing consumers with preference to customize their voice mail system in order to tailor the function of the system to their desired preferences.

17. Claims 4, 12, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bayne, US Pat No: 7,158,621 in view of Pende US Pat No: 6,298,056 B1.

**Claims 4, 12, 16 and 20:**

Bayne discloses the limitations as shown above.

Bayne discloses:

- *billing said advertiser includes charging said advertiser an advertiser fee* (see at least column 5, lines 17-19) *and*

Bayne does not, but Pende, however does disclose:

- *crediting a user a portion of said advertiser fee* (see at least column 2, lines 61-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Bayne's advertising incoming and voice messaging calls with Pende's crediting



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subscriber of telephony service facilitation with the motivation of enhancing user experience and increasing telephone service providers' profitability and marketability.

### ***Conclusion***

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Yehdega Retta/  
Primary Examiner, Art Unit 3622